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Nancy J. Dodd

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PRIEST & GOLDSTEIN PLLC
5015 SOUTHPARK DRIVE
SUITE 230
DURHAM, NC 27713-7736

EXAMINER

GREIMEL, JOCELYN

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/036,605	Applicant(s) DODD ET AL.	
	Examiner JOCELYN GREIMEL	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is in response to Applicant's Amendments and Remarks filed 10 January 2008.

Status of Claims

Claims 1-32 are currently pending.

Response to Arguments

In response to Applicant's request for a copy of the provisional application for Cadigan (U.S. Application Serial No. 10/028,964 filed December 27, 2001 which in turn claims the benefit of Provisional Application No. 60/280,146 filed on April 2, 2001), the Examiner has reviewed the 150 page provisional application and believes it remains applicable as prior art. If the Applicant would like to obtain a copy of the provisional application, one may be obtained as provided by 37 C.F.R. 1.14.

37 CFR 1.14

(iv) Unpublished abandoned applications (including provisional applications) that are identified or relied upon. The file contents of an unpublished, abandoned application may be made available to the public if the application is identified in a U.S. patent, a statutory invention

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registration, a U.S. patent application publication, or an international patent application publication of an international application that was published in accordance with PCT Article 21(2). An application is considered to have been identified in a document, such as a patent, when the application number or serial number and filing date, first named inventor, title and filing date or other application specific information are provided in the text of the patent, but not when the same identification is made in a paper in the file contents of the patent and is not included in the printed patent. Also, the file contents may be made available to the public, upon a written request, if benefit of the abandoned application is claimed under 35 U.S.C. 119(e), 120, 121, or 365 in an application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, or an international patent application that was published in accordance with PCT Article 21(2). A copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application may be provided to any person upon written request, and payment of the appropriate fee (§ 1.19(b)).

In reference to Applicant's Rule 131 Declaration of Nancy J. Dodd, Charla M. Parker and Traci L. Whitney, the Declaration is found to be defective and will not be

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considered. The affidavit does not comply with the provisions of 37 C.F.R. 1.183 as detailed below:

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified

under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not

possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. Where one or more of the named inventors of the subject matter of the rejected claim(s) (who had originally signed the oath or declaration for patent application under 37

CFR 1.63) is now unavailable to sign an affidavit or declaration under 37 CFR 1.131, the

affidavit or declaration under 37 CFR 1.131 may be signed by the remaining joint inventors provided a petition under 37 CFR 1.183 requesting waiver of the signature of the unavailable inventor be submitted with the affidavit or declaration under 37 CFR 1.131. Proof that the non-signing inventor is unavailable or cannot be found similar to the

proof required for a petition under 37 CFR 1.47 must be submitted with the petition under

37 CFR 1.183 (see MPEP § 409.03(d)). Petitions under 37 CFR 1.183 are decided by the Office of Petitions (see MPEP § 1002.02(b)).

Applicant's arguments with respect to claims 1-32, filed 10 January 2008, have been fully considered but they are not persuasive as detailed in the rejection below.

Applicants contend that the data that is submitted and processed by the system is of a different type. The references must be examined together. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of

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references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cadigan et al (US Pub. No. 2004/0093242 A1, hereinafter Cadigan) and further in

view of Enhanced Claims Processing Capabilities Bolster First American Default Management Solutions (hereinafter, Claims Processing). In reference to claims 1 and 24, Cadigan discloses a method and system for automatically processing claims comprising:

- a. a central server computer for receiving inputs from, and providing outputs to, a servicer terminal connected into a network, the servicer terminal capturing data from a servicer submitting an insurance claim (page 1, 0009-0010; page 2, 0024-0025;
- b. a claims database connected into the network, containing data relating to an insurance claim (page 1, 0009-0012; page 2, 0026);
- c. a claim audit rulebase connected into the network, for automatically performing an audit and adjustments of the submitted insurance claim, providing results of the audit and adjustments to the servicer at the servicer terminal, and presenting the servicer with an option to interact with a claim representative to resolve any issues (page 1, 0010-0012; page 2, 0026).

Cadigan does not disclose a claim audit rulebase including rules directed to determine whether loss can be mitigated by acquisition by the insurer of a property subject to the insured mortgage loan. However, Claims Processing is a comprehensive claim processing system designed for processing mortgage insurance claim types. Claims Processing details the system's loss mitigation component and default management solutions. The system allows for accurate claim filings and reduces time associated with claims processing as a default management, query and reporting tool for servicers.

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It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the claims processing system of Cadigan with the mortgage processing details of Claims Processing because it would provide a comprehensive system and architecture for services, processors and clients, making the system more user friendly and efficient for all parties.

In reference to claims 11 and 14, Cadigan discloses a method and system for automatically processing mortgage insurance claims comprising:

- a. a web server administering a network of servicer terminals connected into a network, each servicer terminal running web browser software for viewing web pages served by the web server (page 1, 0009-0010; page 2, 0024-0025);
- b. the web pages including a claim submission form for receiving claim submission data from a servicer at a servicer terminal (page 1, 0009; page 3, 0040-0042); and
- c. a transaction server connected to the web server, the transaction server accessing a claim audit rulebase and a claims database to automatically perform an audit and adjustment for a claim submitted at a servicer terminal, and to automatically provide results of the audit and adjustment to the servicer at the servicer terminal (page 2, 0011-0012).

Cadigan does not disclose the transaction server including rules directed to determine whether loss can be mitigated by acquisition by the insurer of a property subject to the insured mortgage loan. However, Claims Processing is a comprehensive claim

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processing system designed for processing mortgage insurance claim types. Claims Processing details the system's loss mitigation component and default management solutions. The system allows for accurate claim filings and reduces time associated with claims processing as a default management, query and reporting tool for servicers. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the claims processing system of Cadigan with the mortgage processing details of Claims Processing because it would provide a comprehensive system and architecture for services, processors and clients, making the system more user friendly and efficient for all parties.

In reference to claim 27, Cadigan discloses a method for automatically processing claims comprising: receiving an electronic feed of claims data from a centralized claim repository service company (page 1, 0009-0012; page 2, 0024-0025); storing the received data in a sequential dataset in a claims file on a system mainframe; running a mainframe job to look for the claims file on the mainframe; loading data from the claims file into a claims database (page 3, 0033-0034 and 0040-0041); identifying all claims loaded into the claims database; executing a claim audit rulebase for each identified claim; updating the claims database with claim status and audit results from the claim audit rulebase; and making claims available for viewing by servicers on a website (page 4, 0051-0052). Additionally, in reference to claims 30-32, Cadigan does not disclose the data and information being processed to include property data, interest due data or Uniform Mortgage Insurance Claim for Loss information. Cadigan does not disclose a

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claim audit rulebase including rules directed to determine whether loss can be mitigated by acquisition by the insurer of a property subject to the insured mortgage loan. Claims Processing is a comprehensive claims processing system designed for processing mortgage insurance claim types (including property data, interest due data and Uniform Mortgage Insurance Claim for Loss information). Claims Processing details the system's loss mitigation component and default management solutions. The system allows for accurate claim filings and reduces time associated with claims processing as a default management, query and reporting tool for servicers. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the claims processing system of Cadigan with the mortgage processing details of Claims Processing because it would provide a comprehensive system and architecture for services, processors and clients, making the system more user friendly and efficient for all parties.

In reference to claims 2-10, Cadigan discloses a method for automatically processing claims wherein: data entry fields are automatically pre-filled using stored data (page 1, 0011); a document generator generates a settlement letter for servicer (page 1, 0010); the claim audit rulebase determines if a payment is to be made and the projected date of payment (page 4, 0048; page 4, 0058); servicer is provided with a detailed explanation of policy exceptions identified by the rulebase (page 1, 0010-0012); a claim representative terminal connected into the network for allowing a servicer to communicate with the claim representative (abstract; page 1, 0010); the servicer

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communicates with the claim representative using e-mail (abstract; page 1, 0010); the servicer terminal runs a web browser and web server computer sending web pages to the servicer terminal (page 2, 0029); a transaction server for relaying data among the server computer, the claim audit rulebase and the claims database; and a document generator connected to the web server (page 1, 0009-0010). However, Cadigan does not disclose a claim audit rulebase including rules directed to determine whether loss can be mitigated by acquisition by the insurer of a property subject to the insured mortgage loan. Claims Processing is a comprehensive claims processing system designed for processing mortgage insurance claim types. Claims Processing details the system's loss mitigation component and default management solutions. The system allows for accurate claim filings and reduces time associated with claims processing as a default management, query and reporting tool for servicers. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the claims processing system of Cadigan with the mortgage processing details of Claims Processing because it would provide a comprehensive system and architecture for services, processors and clients, making the system more user friendly and efficient for all parties.

In reference to claims 28-29, Cadigan discloses a method for automatically processing claims including: determining whether there have been any errors in loading the claims into the claims database and if there are any errors informing a system support group; and automatically generating an e-mail message informing a claim submitter that a

claim has been received and that an audit has been completed (page 3, 0037). However, Cadigan does not disclose a claim audit rulebase including rules directed to determine whether loss can be mitigated by acquisition by the insurer of a property subject to the insured mortgage loan. Claims Processing is a comprehensive claims processing system designed for processing mortgage insurance claim types. Claims Processing details the system's loss mitigation component and default management solutions. The system allows for accurate claim filings and reduces time associated with claims processing as a default management, query and reporting tool for servicers. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the claims processing system of Cadigan with the mortgage processing details of Claims Processing because it would provide a comprehensive system and architecture for services, processors and clients, making the system more user friendly and efficient for all parties.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOCELYN GREIMEL whose telephone number is (571)272-3734. The examiner can normally be reached on Monday - Friday 8:30 AM - 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jocelyn Greimel
Examiner, Art Unit 3693
July 2, 2008

/Stefanos Karmis/
Primary Examiner, Art Unit 3693